

Remarks

By this response, claims 77, 78 and 85 have been amended. As support for the amendments is provided for by the specification and drawings as originally filed, no new matter has been entered.

Interview Summary

A telephonic interview was conducted between Examiner Sherr and the undersigning attorney on March 7, 2011 (10 am). The Examiner is thanked for taking the time to discuss the claim amendments presented by this response. In particular, the amendments to claims 77, 78, and 85 were discussed. Although no agreement was reached as to the allowance of the claims, the Examiner indicated that such amendments appear to address the below mentioned restriction and overcome the below mentioned 35 USC § 112, second paragraph issues. Both Dolphin (US 5,457,746) and Katz et al. (US 5,926,624) were discussed, however, the Examiner indicated that she would need to re-read these references in light of the Applicant's assertion that the publisher's workstation is remote from the user's computers, such that the recited limiting relationship between the elements of the claims is not disclosed by the cited art. As the next procedural step, Applicant submits this response.

Election/Restriction

Claims 85-108 were withdrawn by the Examiner since asserted as being drawn to a method and apparatus for distributing digital data, classified in class 709, subclass 219. Claim 85 has been amended to be more clearly drawn to a point of sale apparatus interacting with a remote license center. Accordingly, it is believed that claims 85-108 are now direct to the elected invention, and thus should be rejoined in the application for examination on the merits.

35 USC § 112, second paragraph

By the above amendments, claims 77 and 78 now recite structure without reciting method steps for use. Furthermore, claims 77 and 78 have been amended to be directed to an electronic digital media production system, which implies that the recited elements are hardware which are configured to perform the recited functions. Support for such an amendment is provided by, e.g.,

Fig. 1 and the associated brief description of the drawing provided in the specification as originally filed. Accordingly, it is believed that the claims particularly point out and distinctly claim the subject matter which the Applicant regards as the recited invention. Withdrawal of this rejection is respectfully requested.

35 USC § 103

Claims 77-84 are rejected under 35 USC 103(a) as being unpatentable over Dolphin (US 5,457,746) in view of Katz et al. (US 5,926,624). This rejection is respectfully traversed in view of the following comments as the asserted combination fails to teach or suggest each and every feature of at least the independent claims.

Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render claims 77 and 78 unpatentable, however, the Office must do more than merely “consider” each and every feature for these claims. Instead, the asserted combination of the patents to Dolphin in view of Katz must also teach or suggest each and every claim feature. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (to establish prima facie obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has previously confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. It is believed that the Examiner has failed to do so in this instance.

First, Applicant notes, at page 5 of the Office Action, the Examiner point to two different localities as reading on the recited “local site”, that is Dolphin’s user computer (col. 4, line 55-67) and Dolphin’s publishers workstation (col. 5, lines 7-16). Such an assertion is incorrect and ignores the all limitations requirement. As a first matter, even though the feature of a local site is presented in the preamble, such a recited feature should be accorded patentable weight. It is established law that when a preamble of a claim provides more than just context for the claimed invention, that preamble should be given patentable weight. Indeed, when, as is the case here,

the body of the claim expressly refers to features in a preamble and uses those referenced features to define the claimed invention, it is legal error not to give that preamble patentable weight.

A preamble is entitled to patentable weight when it is “necessary to give life, meaning, and vitality” to the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). The Federal Circuit has held that a preamble may give “life, meaning and vitality” to a claim either: (1) explicitly (the claim expressly uses the preamble and the body of the claim to define the claimed invention); or (2) implicitly (proper construction of the claim requires reference to the preamble).

Claims 77 and 78 both recites “a release unit located at the local site... a media generator located at the local site; a packaging generator located at the local site; and a control unit located at the local site...” And, this local site is expressly defined by the claim preamble as being remote from a licensing control center, which the body of claims 77 and 78 also expressly incorporates. In this way, the body of the claim depends on the preamble for completeness and gives life, meaning, and vitality to this claim. For this reason alone, the preamble of claims 77 and 78 should be afforded patentable weight. See MPEP 2112.02(II). Moreover, the preamble of claims 77 and 78 should be afforded patentable weight for still another reason. MPEP 2112.02(I) instructs that preambles that limit structure must be given patentable weight. In this regard, the preamble feature of a local site defines the recited system with an arranged structure not found in the applied art. Thus, the preamble of claims 77 and 78 must be given patentable weight.

As a second matter, Dolphin explicitly discloses that in reference to FIG. 1, box 11 (the user/ subscriber’s site) and box 12 (the publisher’s workstation site) are two different portion of the overall system which overlap at box 13. See Fig. 1, col. 4, lines 24-26, and 55-64. In other words, the publisher’s workstation is remote from the user’s computer. Such an assertion is further supported in view of Dolphin’s explicit teaching that the CD-Rom containing encrypted data is mailed via Postal Mail to the user, which can then be distributed via interoffice mail if the user is in a corporation, government or legal environment, or that the data is accessible on server 25, which is depicted in Fig. 1 as being remote from both the user’s computer and the publisher’s workstation (id., lines 45-58). Dolphin, therefore, does not teach or suggest the limitations of claims 77 and 78 of “a release unit located at the local site... a media generator located at the

local site; a packaging generator located at the local site; and a control unit located at the local site..."

Claim 77 and 78 are also limited to on demand manufacturing at a local site of a selected digital information product selected by a customer at the local site to a physical media – which is not described or suggested by the any of cited prior art – Dolphin or Katz, individually or when viewed together. For example, Dolphin is a post manufacture access control mechanism to prevent unauthorized uses of data, not for preventing unauthorized manufacture of a selected digital information product selected by a customer at the local site to a physical media. Dolphin implies use of standard mass production techniques to replicate discs that are generated on a publisher's workstation to distribute. Such discs are the sent to end users that are remote from the publisher's workstation, who request access to the data on the disc from their home computer (such as over the internet). As such, there is no request (or point of sale) involved at the local site which manufactures the discs as is required by the claims. Dolphin describes sending discs to customers via standard distribution channels, such as the postal service (see for example, col. 4, line 48). Clearly, the system of Dolphin does not manufacture on-demand at a local site a physical media which contains a digital information product selected by the customer also at the local site as recited by the claims.

Katz discloses a computer network based digital information library system which uses authorized playback devices and is cited for teaching that processing continues if systems in the system are authorized systems. Therefore, Dolphin and Katz combined teach electronic distribution of digital content direct to an end user using an end user's computer. Such is not the claimed invention.

Claims 77 and 78 also recite the limitation of "a control unit located at the local site and which...also prevents the complete generation of any other digital information product before receipt of another electronic release code unique only to the other digital information product from the remote licensing control center."

It is noted that the authorization code of Dolphin is not used to control manufacture of the physical media. To cure this deficiency the Examiner points to Katz. However, it is noted also that the system of Katz does not prevent the manufacture of the physical media before receipt of a unique electronic release code in the manner as recited by the above claims. Katz uses an

authorization system in which a library server will send digital content to a client computer that has an authorized electronic software player (and physical software player) and the software player will only access digital content from an authorized library server, which appears to be akin to the present day i-Tunes software from Apple. However, once the software player(s) of Katz is authorized all digital content on the library server is viewable on the client computer via the software player. Clearly, by the above-mentioned limitations such is not the recited invention of claims 77 and 78.

Other shortcomings are noted in the teachings of the cited prior art. For example, Dolphin does not describe a mass data storage device located at the local site as explicitly recited. Dolphin describes two subsystems (col. 4, lines 4-5), one subsystem is where the publisher defines their data prior to mastering, the other is where a user having received a mass produced copy of the master (col. 6, lines 39-41) requests the decryption key to access a portion of the data (col. 4, lines 48-54). The publisher's storage device, where they master data and the end users local computer cannot be described as both being in the same local site. As Katz fails to cure this noted deficiency, claims 77 and 78 also appear patentable over the cited art on this basis also.

Dolphin also does not describe a media generator generating the selected digital information product by storing on the physical media the digital information and by recording on the physical media the issued unique release code. Dolphin does describe a writer device (col. 5, line 9), but this is to create a master to be replicated (col. 6, line 39-41), not a unique instance. Dolphin does not write a unique release code, it merely writes one or more Key Material Identifiers (col. 6, line 22) on to the media which are used to later identify the encrypted content and not uniquely identify the individual disc. Dolphin does not teach anything about controlling the replication process and is not concerned with controlling or auditing replication only controlling use of the data on the replicated media. As Katz fails to cure this noted deficiency, claims 77 and 78 also appear patentable over the cited art on this basis also.

As the remaining claims depend either directly or indirectly from claims 77 and 78, in view of the above comments, such claims are also believed patentable over the cited art.

Conclusion

The Applicant respectfully submits that, in view of the above amendments and remarks, the application is now in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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